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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,377	05/22/2001	Edward P. Daniels JR.	F-170	8688
919 7590 04/29/2009 PITNEY BOWES INC. 35 WATERVIEW DRIVE MSC 26-22 SHELTON, CT 06484-3000				
EXAMINER				
LE, MIRANDA				
ART UNIT		PAPER NUMBER		
2159				
NOTIFICATION DATE		DELIVERY MODE		
04/29/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[iptl@pb.com](mailto:iptl@pb.com)

### Office Action Summary

**Application No.**

09/862,377

**Applicant(s)**

DANIELS ET AL.

**Examiner**

MIRANDA LE

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/12/09 has been entered.

This communication is responsive to Amendment, filed 02/12/20059.

Claims 1-4, 8, 11-13 are pending in this application. This action is made non-Final.

The rejection of claims 8, 13 under 35 U.S.C. §101 has been withdrawn in view of the amendment.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

#### **Claims 1-4, 11-12 are directed to non-statutory subject matter.**

In accordance with 35 USC § 101, a patentable process must (1) be tied to a particular apparatus or machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *See In re Bilski*, 2007-1130 (Fed. Cir. 2008) *slip op at 10-11* ("The Supreme Court, however, has

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enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing").

Independent claim 1 is not tied to a particular apparatus or machine because the steps of "compiling a database...; receiving...; locating ..." do not necessarily involve the use of a computer or machine. Notably, reciting "using a computerized system" in the preamble holds no patentable weight unless it is suggested in the body of the claim. The method of claim 1 defines a sequence of operational steps that encompasses within its scope merely a set of mental manipulations that provides an output remaining in the mental realm. Therefore, claim 1 is not tied to a particular apparatus or machine.

In addition, claim 1 does not transform the underlying subject matter (data) into a different state or thing. Thus, claim 1 is directed to a non-statutory process.

Claims 2-4, 11-12, are dependent upon claim 1, do not add any limitations which correct the deficiencies of claim 1, and are therefore also similarly rejected.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-4, 8, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balma et al.(US Patent No. 6,157,945), in view of Rodriguez et al. (US Patent No. 7,124,087).**

**As to claims 1, 8,** Balma teaches a method for locating a recipient of a message in a corporation using a computerized system, comprising:

compiling a database (*i.e. An intelligent program called a software agent may investigate various databases in an automatic fashion in order to determine the recipients intended location. If desired, travel schedules or locations which are utilized or visited by the recipient on more than one occasion may be programmed into the system as a template. Thus, when the recipient takes a trip for which a corresponding template has already been stored, the recipient may*

*simply indicate the dates of the trip which correspond to the location(s) of the trip without entering the communication mode and addressing information each time. Such a template allows a rapid programming of the scheduling information, col. 2, lines 41-52) of a recipient's scheduled location (i.e. a recipient based on scheduling information), a recipient's delivery preference (i.e. using the mode of communication which is preferred by the recipient, col. 1, lines 37-43), and a corporation's preference (i.e. In order to transmit or forward communications to the recipient, it is necessary to know the preferences or profile of the recipient. FIG. 5 illustrates a record or fields of a record of a user database for storing the communication preferences of the recipient. The user database 200 includes a position 202 of the recipient such as his or her title such as vicepresident, manager, etc. The position 202 may be used to filter incoming communications. For example, only people who have direct (or relatively close) reporting relationships with a person may be able to send mail to that person. In addition to or as an alternative to this concept, the position 202 which may be considered a ranking may dictate that only communications from people of a certain position level or ranking are forwarded, such as when the intended recipient is on the road. Such a concept functions like corporate spam filtering. An advantage of this concept is that higher ranking people within a corporation or organization will not be overwhelmed with communications. When the higher ranking person is on the road or away from his/her normal location, this could be a significant problem. An organization/department field 204 is utilized to store other information of the*

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*recipient such as the company and department of the company in which the recipient works, col. 7, line 54 to col. 8, line 8);*

*receiving an updated schedule location and/or delivery preference in the database (i.e. The selecting of the location and corresponding addressing information and communication mode may be performed temporally, for example using scheduling information in conjunction with time information. When the time program med in the scheduling information is reached, the routing of communications is automatically changed, col. 2, lines 1-6); and*

*locating the recipient in response to a user inquiry to the system, comprising:*

*generating a merged preference set by merging the recipient's delivery preference and the corporation's preference (i.e. Alternatively, the location information of the recipient may be obtained from a computer of the travel agent or from a scheduling program of the recipient which is generally used to keep track of appointments and/or the recipient's schedule and therefore, the traveler location information does not have to be input a second time just for the forwarding of communications, col. 2, lines 34-40); and*

*providing to the user the updated scheduled location and the merged preference set to facilitate delivery of the message (i.e. The ability to keep track of the location of a person allows the system, if desired, to search for the location of the recipient in order to properly deliver a communication. Such a feature would be advantageous when the information defining the location of the user, user profile, or travel itinerary of the user is incomplete, or the information*

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*defining the location of the user was corrupted or destroyed, col. 15, lines 11-17) to the recipient at the updated scheduled location (i.e. Another manner of obtaining information regarding the travel schedule of the intended recipient is to pull information from existing databases, for example such as from a form which is utilized by a company to monitor an employee's travel schedule or expenses. As these forms contain information which is already input into a computer, there is no redundancy required and the user does not have to enter the information again. In FIG. 11, after starting the user or another person enters travel itinerary or a vacation schedule into a company form in step 452. Alternatively, any other type of form may be utilized in this embodiment which is preferably used by a different program, in addition to the program for controlling the routing of communications. In step 454, delivery parameters are entered including addressing information, the preferred mode of delivery, alternative modes of delivery, and delivery parameters in a similar manner as is performed in step 432 of FIG. 10. The user profile is updated in step 456 and the process of FIG. 11 ends. In FIG. 11, if desired, a software agent may be utilized to obtain the information which was entered with respect to the forms or the information may be obtained in any other desired manner, col. 11, lines 46-67).*

Balma implicitly teaches "providing to the user the updated scheduled location and the merged preference set to facilitate delivery of the message to the recipient at the updated scheduled location" at col. 15, lines 11-17 and col. 11, lines 46-67.



Rodriguez, however, specifically teaches this limitation (*i.e. Once the actions are accepted, various processes take place depending upon the action and the user's preferences. One action is designed to notify the company mailroom of the user's delivery instructions, Summary*).

It would have been obvious to one of ordinary skill in the art having the teaching of Balma and Rodriguez at the time the invention was made to modify the system of Balma to include the limitations as taught by Rodriguez. One of ordinary skill in the art would be motivated to make this combination in order to notify the company mailroom of the user's delivery instructions in view of Rodriguez (Summary), as doing so would give the added benefit of having the mailroom known whether to hold the user's mail, forward it to another location, or deliver the mail to the user upon his return as taught by Rodriguez (col. 9, lines 66 to col. 10, lines 15).

**As per claim 2**, Balma, as combined, teaches the method as claimed in claim 1, wherein the updated scheduled location is provided by the recipient (*i.e. In step 306 the various parameters of the communication forwarding are entered including the time range for forwarding the communication, the preferred delivery mode (e.g., facsimile), the alternative delivery mode(s) (e.g., use electronic mail if a facsimile delivery is not successful), and any other delivery parameters including whether a log on or other check in is required in order to instigate delivery of a communication, the number of times a communication is to be retried before using an alternative mode of communication, addressing*

*information such as a telephone number, or any other parameters used to schedule or route or control the routing or forwarding of the communication. ... the use of manual inputting of information, for example, using a graphical user interface, using a text interface, or by reading information entered using a different program. The process of FIG. 6 then ends, col. 9, line 47 to col. 10, line 8).*

**As per claim 3,** Balma, as combined, teaches the method as claimed in claim 1, wherein the updated scheduled location is received via a computer based network (*i.e. Communication line 108 is preferably a telephone line, although any other communication media including wireless communications may be utilized to transmit and receive information utilizing the modem 106. A network interface 110 is connected to a network 112 which may be any type of network including a local area network, a wide area network, and the Internet, col. 5, lines 20-42).*

**As per claim 4,** Balma, as combined, teaches the method as claimed in claim 1, wherein the updated scheduled location is received via telephone (*i.e. Communication line 108 is preferably a telephone line, although any other communication media including wireless communications may be utilized to transmit and receive information utilizing the modem 106. A network interface 110 is connected to a network 112 which may be any type of network including a local area network, a wide area network, and the Internet, col. 5, lines 20-42).*

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**As to claims 11, 13,** Rodriguez, as combined, teaches the message comprises a mailpiece (*i.e. Once the actions are accepted, various processes take place depending upon the action and the user's preferences. One action is designed to notify the company mailroom of the user's delivery instructions, Summary*).

**As per claim 12,** Rodriguez, as combined, teaches the method of claim 11, further comprising delivering the mailpiece to the recipient at the updated scheduled location (*i.e. Mailroom actions 365 are transmitted to the company mailroom 370 using email or another protocol used by the mailroom for receiving instructions. The mailroom will now know whether to hold the user's mail, forward it to another location, or deliver the mail to the user upon his return. Parcel service action 375 likewise informs the common home parcel services 380 used by the user that parcel deliveries should be left with a neighbor, held for customer pickup, or delivered when the user returns. Postal service action 385 likewise informs the post office branch serving the user that mail services should be stopped, delivered when the user returns, or forwarded to another address. Mailroom actions 365, parcel service actions 375, and post office actions 385 may alternatively use encryption and digital signatures or digital certificates to verify that the user has authorized the mail instructions and for security regarding the user's whereabouts, col. 9, line 66 to col. 10, line 15*).

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### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4, 8, 11-13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James K. Trujillo, can be reached at (571) 272-3677. The fax number to this Art Unit is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Miranda Le/

Primary Examiner, Art Unit 2159